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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/404,269	10/15/1999	TERRENCE J. O'HANLON	7415/0G062	8234
7590	04/06/2005		EXAMINER	
DARBY & DARBY PC 805 THIRD AVENUE NEW YORK, NY 10022			CAMPEN, KELLY SCAGGS	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/404,269	O'HANLON ET AL.
	Examiner Kelly Camper	Art Unit 3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 2-32 is/are pending in the application.
- 4a) Of the above claim(s) 22-24, 30 and 31 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 2-21, 25-29 and 32 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1-13-05.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/07/05 has been entered.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2-21, 32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed method consists solely of the manipulation of an abstract idea and is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459. In addition, the claim is devoid of any limitation to a practical application in the technological arts. The invention in the body of the claim must recite technology. If the invention, in the body of the claim, is not tied to technological art, environment, or machine, the claim is not statutory (see *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001). Also note MPEP 2106 IV 2(b). Examiner notes that this is not a precedential decision but it is being cited for its analysis of whether the claim is in the technological arts.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 2-21 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown (US5832448).

Specifically as to claim 1, Brown discloses a method for compiling health information, performed by a computer controlled apparatus by establishing a database for storing a plurality of health statuses of a plurality of users (col. 1), wherein the database is centrally accessible (col. 3-4), receiving data corresponding to a health statistic of the user (col. 4), the data generated by a health monitoring device (col. 4); determining a health status of the user from the health statistic (col. 4-8); storing the health status in the database and updating a population statistic based on the health status and the plurality of health statuses (col. 4-9).

Specifically as to claims 3-21, 32, see above for claim 2.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 25-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown (US5832448).

Specifically as to claim 25, Brown discloses a method for submitting cardiovascular data to a central database by receiving a request to detect a cardiovascular signal of the user; initializing a cardiovascular monitoring device connected to a computer in response to the request; measuring the cardiovascular signal with the cardiovascular monitoring device while a startup routine performed by the computer is ongoing; analyzing a waveform, receiving, after the startup routine, at least a portion of the detected cardiovascular signal of the user; and transmitting data based on the received cardiovascular signal to a central database for storage in a record corresponding to the user (see Brown, figure 6, and column 9).

Specifically as to claims 26-29, see above rejection for claim 25.

Claims 25-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Langer et al. (US5966692). Alternatively, Langer et al. also anticipate claims 25-29.

Specifically as to claim 25, Langer et al. disclose a method for submitting cardiovascular data to a central database by receiving a request to detect a cardiovascular signal of the user; initializing a cardiovascular monitoring device connected to a computer in response to the request; measuring the cardiovascular signal with the cardiovascular monitoring device while a startup routine performed by the computer is ongoing; analyzing a waveform, receiving, after the startup routine, at least a portion of the detected cardiovascular signal of the user; and transmitting data based on the received cardiovascular signal to a central database for storage in a record corresponding to the user (see figures 2 and 5; see col. 1, lines 35-60, col. 2, lines 50-67).

Specifically as to claims 26-29, see above rejection for claim 25.

#### ***Response to Arguments***

Applicant's amendments, filed 1/7/2005, with respect to the specification have been fully considered. The objection of specification has been withdrawn.

Applicant's arguments filed 1/7/2005 have been fully considered but they are not persuasive.

In response to Applicant's argument that Brown does not disclose calculating a mean value for each patient from the patient's own set of measurements, without comparison to statistics derived from the health statuses of other users, Examiner disagrees and refers to Brown, col. 2, lines 10-40.

In response to Applicant's argument that Brown and Langer do not disclose "startup routine" this is also inherent. All computers when turned on begin a start up routine. In addition to the argument that Brown and Langer don't disclose analyzing the waveform, see Brown, col. 5 and Langer col. 3, lines 25-65.

In response to applicant's arguments, the recitation "acoustical" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The database in Brown is capable of performing the same function as the database claimed in claim 2. The claim merely states that the database needs to be accessible. It is inherent in the Brown patent that the database is accessible to the Internet (in addition, see Brown, col. 5, lines 50-65 and the collection of email addresses). Any computer which is tied into the Internet (as ones at a medical facility are) is accessible.

In response to applicant's argument, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.

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See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Campen whose telephone number is (703) 308-0780. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kelly Scaggs Campen